



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,930	06/27/2003	Balwinder S. Bhatti	T103 1530.1	8695
26158	7590	06/09/2004	EXAMINER	
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC			DESAI, RITA J	
P.O. BOX 7037			ART UNIT	
ATLANTA, GA 30357-0037			PAPER NUMBER	
			1625	

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/607,930	BHATTI ET AL.	
	Examiner	Art Unit	
	Rita J. Desai	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-44 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1-11, 21-31 and 41-44 in part, drawn to compounds and pharmaceuticals wherein the core is a diazospiro nonane, wherein the Cy group is a pyridyl, classified in class 546, 514 and in various subclasses.
- II. Claims 1-11, 21-31 and 41-44 in part, drawn to compounds and pharmaceuticals wherein the core is a diazospiro decane and the cy group is pyridyl, classified in class 546, subclass 18.
- III. Claims 1-11, 21-31, and 41-44 in part, drawn to compounds and pharmaceutical compositions wherein the core is a diazospiro octane and the cy group is a pyridyl, classified in class 546 and various subclasses.
- IV. Claims 1-11, 21-31, 41-44 in part, drawn to compounds and pharmaceutical compositions wherein the core is a diazospiro undecane and the cy is a pyridyl, classified in class 546, subclass 18.
- V. Claims 1-11, 21-31, 41-44 in part, drawn to compounds and pharmaceutical compositions wherein the core is a spiro[1-azabicyclo[2.2.1]heptane-2,3'-pyrrolidine], classified in class 549, and various subclasses.
- VI. Claims 1-11, 21-31, 41-44 in part, drawn to compounds and pharmaceutical compositions, wherein the core is a spiro[1-azabicyclo[2.2.2]octane-2,3'-pyrrolidine], classified in class 549 and various subclasses.

Art Unit: 1625

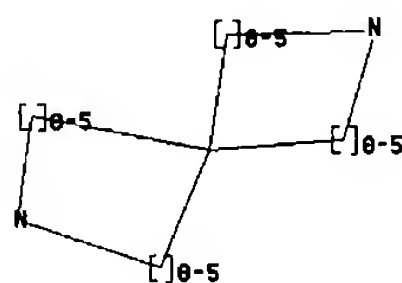
- VII. Claims 1-11, 21-31, 41-44 in part, drawn to compounds and pharmaceutical compositions, wherein the core is a other than the ones given in the above groups, classified in various classes and subclasses. A further election of a single disclosed species is required. May be subject to further restriction.
- VIII. Claims 12-20, 32-40, drawn to various method of treating, classified in class 514 and various subclasses. May be subject to restriction, since there are various method of treating.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have a different core and hence different bonding and properties.

When a preliminary search was done on the core, it did not run.

See below:-



=> s 11

STRUCTURE TOO LARGE - SEARCH ENDED

A structure in your query is too large. You may delete attributes or atoms to reduce the size of the structure and try again.

Inventions I-VII and VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case there are numerous drugs that are used to treat the the different diseases as claimed, hence the process for using the product as claimed can be practiced with another materially different product.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicants preserve their right to file a divisional on the cancelled non-elected subject matter, without prejudice in due course.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II to VIII or vice versa, restriction for examination purposes as indicated is proper.

REJOINDER:- If applicants elect a group from groups I-VII and if it were to be found allowable then ONE method of treating claim limited to the same scope as the compounds and pharmaceutical compositions , shall be rejoined and allowed provided it is free from all 112 issues.

Art Unit: 1625

A telephone call was made to Mr. Massey on 6/3/04 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, 9:30 am to 6:00 pm.

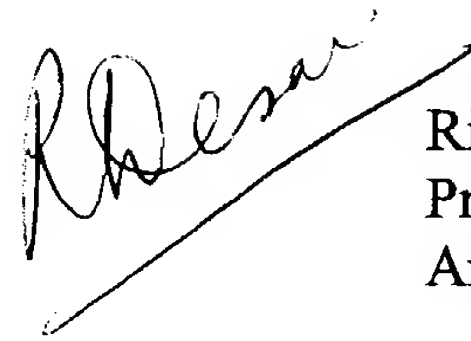
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/607,930

Page 6

Art Unit: 1625

A handwritten signature in cursive script, appearing to read "R. Desai", with a long horizontal line extending from the end of the signature.

Rita J. Desai
Primary Examiner
Art Unit 1625

R.D.
June 3, 2004

6/3/04